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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/632,139	08/03/2000	Ryoichi Imanaka	MAT-3720US4	2101
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Ratner & Prestia P O Box 980 Valley Forge, PA 19482			EXAMINER BROWN, RUEBEN M	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

09/632,139

Applicant(s)

IMANAKA, RYOICHI

Examiner

REUBEN M. BROWN

Art Unit

2424

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 60-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 60-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CI/CD)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s) Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 4/5/2010 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 60-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horton, (U.S. Pat # 4,945,563) in view of Brownstein, (U.S. Pat # 5,671,202) and Cohen, (U.S. Pat # 4,949,187) and Garneau, (U.S. Pat # 5,675,647).

Considering amended claim 60, the claimed computer information system comprising a provider for providing information to a recipient reads on the central office connected to the cable TV or satellite distribution system; see Horton col. 3, lines 61-68.

Regarding the further claimed limitation of a *'provider receiving signaling from a recipient for the provider to provide the information to the recipient'*, even though the background of Horton mentions PPV, col. 1, lines 10-40, the invention itself does not explicitly

discuss transmitting any subscriber requests to a headend for transmission of a movie.

Nevertheless Cohen, which is in the same field of endeavor, of transmission of a movie to a subscriber terminal, includes a further teaching of the subscriber entering a movie selection via a keypad 102, which is transmitted upstream to a central source 4; see col. 3, lines 61-67; col. 4, lines 47-64; Fig. 4. In particular, Cohen teaches that the customer orders a particular movie, which is then transmitted to the customer at the appropriate time, see col. 5, lines 1-10. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to operate Horton in a subscriber request system for the desirable benefit of allowing the subscriber to watch whatever movie desired at whatever time desired without needing to drive to movie rental store, as taught by Cohen, see col. 1, lines 12-44; col. 2, lines 3-18; col. 3, lines 9-31.

The additional claimed feature of the 'provider charging a different amount to the recipient depending upon whether the information is recorded or permitted to be recorded' reads on the disclosure of Horton that a subscriber may preview a movie free-of-charge, may be charged a certain amount for viewing the movie and a different amount is charged when the movie is ordered for recording, col. 2, lines 25-67; col. 3, lines 40-55 & col. 4, lines 21-34.

Horton does not teach the amended claimed features, '*to be recorded in a non-sequentially accessible medium*'... '*is permitted if a value of an identifier read from the medium is a registered ID value...recording of the information in the medium is prevented if any registered ID value is not readable from the medium*'. Nevertheless, Brownstein provides a

disclosure of a security system that operates by storing a recording medium signal identification group and/or embedded characters, (which reads on the claimed '*identifier* read from said *recording medium*'), at least in order to prevent inappropriate material from being stored on the instant recording medium, see Abstract; Fig. 5-6; Fig. 8 & 9A-9B; col. 7, lines 31-50; col. 9, lines 35-61 & col. 10, lines 1-26. In particular, Brownstein teaches that in order to store a file, the instant file must contain an identifier that matches an identifier stored on the recording medium to which the file would be stored, see col. 9, lines 36-67; col. 10, lines 41-67 thru col. 11, lines 1-5. Since Brownstein (col. 1, lines 25-50; col. 4, lines 21-31; col. 11, lines 42-58) discloses that the recording medium may include an optical storage disk, as well as a compact disk, CD, the amended claimed feature of the, '*non-sequentially accessible medium*', is met by the reference.

It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Horton with the technique of only recording information on a particular recording medium after verifying that a registered recording medium being identified, at least for purpose of ensuring that only certain files, such as only specific image files are stored on a particular recording medium, as taught by Brownstein, col. 3, lines 20-45 & col. 11, lines 1-17, which teaches that an owner of specific images can control to which recording medium the instant images are stored.

As for the claimed computer information system, Brownstein does not discuss which type of system that the optical storage disks and/or compact disks/CD are used. However, Official

Notice is taken that the use of optical disks and/or compact disks/CD in a PC system was old in the art. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify the combination of Horton & Brownstein with the technology of operating the optical storage disk in a PC system, at least for the desirable advantage of enabling a wide range of interactivity with the instant optical storage disk, inherent in its use in a PC system.

As for the additionally claimed, 'signaling further including a flag indicating an output to which the recipient outputs the information', Cohen does not necessarily teach that the ID of the viewer's terminal is transmitted upstream along with the request for a movie, col. 4, lines 45-67. However Garneau, in the same field of endeavor, provides a teaching that when a consumer makes a request for a movie from a server, that the identification of the consumer's output equipment (i.e., the terminal ID, which corresponds with the claimed, *'flag indicating an output to which the recipient outputs the information'*) is a passed to the server, along with the request, see col. 3, lines 45-67; col. 4, lines 1-25; col. 6, lines 22-45; col. 9, lines 55-67. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify the combination of Horton & Cohen, with the feature of transmitting an identification of the consumer's output equipment (i.e., terminal ID), along with a request for a movie, at least for the desirable purpose as taught by Garneau (col. 1, lines 5-10; col. 1, lines 50-67 thru col. 2, lines 1-53), the server verifying that the instant consumer output equipment is entitled to receive the requested movie.

Considering claim 61, the claimed steps of a method of processing information corresponds with subject matter mentioned above in the rejection of claim 60, and are likewise treated.

Considering claim 62, the claimed elements of a method of processing information that correspond with subject matter mentioned above in the rejection of claim 60, are likewise treated. As for the different feature of 'receiving information from a provider ...', the receiver system of Horton, meets the claimed subject matter, (Fig. 1; col. 3, lines 31-45). Also, both Cohen (col. 4, lines 30-68) & Garneau (Abstract; col. 2, lines 42-60; col. 7, lines 62-67; col. 10, lines 38-44) receive information from the provider, in response to signaling received from the recipient.

Considering claim 63, the claimed elements of a computer information system that corresponds with subject matter mentioned above in the rejection of claim 60, are likewise treated. As for the different feature of a 'recipient for receiving information from a provider...', the receiver system of Horton, meets the claimed subject matter, (Fig. 1; col. 3, lines 31-45). Cohen & Garneau also meet the additionally claimed subject matter.

Considering claim 64, the claimed steps of a method of processing information that correspond with subject matter mentioned above in the rejection of claim 60, are likewise treated. Regarding the additionally claimed, 'the transmitted signal from a recipient of information to a provider of information, such that the signal indicates whether the information

is recorded in a medium... ', this subject matter is met by the disclosure in Horton that the decoder 28 could provide billing information to the store and hold circuit 46, which is then transmitted to the proper billing authority, see col. 3, lines 35-60. The instant billing information shows which viewing mode was selected by the subscriber, and thus what charges are being billed.

Considering claim 65, the claimed elements of an information receiver, correspond substantially with the subject matter mentioned above in the rejection of claims 60 & 63, and are likewise treated.

Considering claims 66-67, the claimed 'provider having a mode recognizing apparatus and recognizing the output to which the recipient outputs the information...' is also met by head end in Garneau recognizing the terminal ID of the requesting customer, and checking the terminal ID against a list of valid ones to determine if the instant terminal ID is valid, see col. 2, lines 38-60. Furthermore, Horton teaches that the system can bill the customer according to the mode of operation chosen by the customer, as indicated by the terminal, (i.e., at least, view only or view & tape, etc.) or may pre-authorize a receiver to receive a particular program and indicate the mode of operation, see col. 3, lines 30-68.

Considering claim 68, as discussed above, both Cohen (col. 4, lines 47-64) and Garneau (col. 2, lines 29-31; col. 4, lines 4-10; col. 6, lines 11-25) includes the identification (i.e.,

programming code) of a selected movie, when the terminal requests the headend/server to transmit the instant selected movie to the particular subscriber terminal. Therefore, both Cohen & Garneau provide a movie to a customer and subsequently bills the customer, according to the identification of the selected movie transmitted in the request to the headend/server, which meets the claimed subject matter.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
- A) Tweedy Teaches a system that confirms a user ID/password with respect to the Terminal ID, when the subscriber does a log-in for requesting authorized programming, see col. 9, lines 39-64.
- B) Clark Teaches a system that uses ANI technology to identify a subscriber and authenticate the instant subscriber for requesting authorized programming, see col. 8, lines 1-35.
- C) Endoh Teaches inhibiting a recording medium from recording certain programming, col. 5, lines 20-65; col. 9, lines 41-65.
- D) Gordon Teaches a server receiving at least the ANI of a customer requesting to view a movie, and subsequently verifying that the customer's equipment is authorized, col. 12, lines 1-13.

Any response to this action should be mailed to:

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P.O. Box 1450
Alexandria, VA 22313-1450
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or faxed to:

(571) 273-8300, (for formal communications intended for entry)

Or:

(571) 273-7290 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reuben M. Brown whose telephone number is (571) 272-7290. The examiner can normally be reached on M-F (9:00-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communications and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Reuben M. Brown/
Patent Examiner, Art Unit 2424